

REMARKS**I. STATUS OF THE CLAIMS**

Claims 22-36 are pending in this application. These claims stand rejected under 35 U.S.C. § 103(e).

II. SUMMARY OF THE CLAIMED SUBJECT MATTER**A. Overview of the Invention and Prior Art****1. The Invention**

A problem with prior techniques for web page design is that it is difficult for writers and artists of web pages to effectively coordinate the locating or creating of media that is needed for each web page. A writer writes the text for a web page and writes specifications ("specs") that describe and identify what media is needed at what locations within a web page. An artist at a later time can review the specifications, locate or create the specified media, and insert the media into the web page. Because of the large size of website development projects, which can include many web pages with numerous pieces of media and numerous specifications, the identification and retrieval of the correct media often becomes confused.

Applicant's invention is directed to a system for managing media that overcome some of the problems of prior techniques. Applicant's system provides a collection of existing specs for media elements. This collection may be created initially by an administrator or developed over time as writers and artists create or modify web pages. Applicant's system displays the existing specs for media elements so that a writer can locate a desired media element. If the writer can locate a desired media element based on review of the existing specs, then an identifier for that media element is inserted into the web page. If, however, the writer cannot locate the desired media element, the writer can create a new spec that describes the desired media element and the new spec is stored in

association with the web page. The spec is stored in association with the web page so that an artist can subsequently retrieve and use the spec to create the desired media element for the web page. After the artist has created the desired media element based on the spec, then an identifier for the created media element is inserted into the web page.

Applicant's system may also provide various other improvements to increase the efficiency of designing web pages. For example, applicant's system may allow a writer to attach a screen shot of the desired media element to a spec, which can help ensure that the artist locates the correct media element. As another example, applicant's system can generate reports of unfilled specs. An artist can use these reports to coordinate and prioritize their efforts in filling the specs. As another example, applicant's system can notify the writer of a spec when the desired media element has been created by an artist. These notifications allow the writer to track progress in completing a project.

2. The King Reference

King describes a technique for three-way separation of information of a document, such as a web page. In particular, the information is separated into content elements, a design description, and a media specification of a document. (King, 2:52-55 and 5:55-58.)

King defines content element, design description, and media specification as follows: Content elements are the content of a document and can include text, images, graphics, and so on. (King, 7:30-35.) A design description describes the overall layout of the document and can include a horizontal brochure format, a single or multi-page format, a newsletter, a calendar, or so on. (King, 7:36-49.) A media specification specifies the media to which a composition is to be rendered and can include a sequence of screen pages, a web site in HTML, a three-dimensional HTML format ("VRML"), paper pages, and so on. (King, 7:50-64.)

To render a document, King's design engine inputs the content elements, the design description, and the media specification of the document and renders the content to the medium in accordance with the design description. (King, 8:47-50.)

B. Independent Claims

The rejected independent claims are directed to a technique for creating a web page.

1. Claim 22

Claim 22 is directed to a method in a media managing software module executing on a computer system for creating a web page. (Specification, 2:26-27.) The software module provides existing specs that describe media elements and displays them to a writer. (Specification, 10:3-11.) When the writer locates a desired media element from the specs, the software module inserts an identifier of the media element into the web page. (Specification, 10:11-14.) When the writer does not locate the desired media element based upon review of the existing specs, the software module creates a spec describing the desired media element as indicated by the writer. (Specification, 10:13-15.) The software module stores the created spec in association with the web page. (Specification, 10:17-19.) After the artist has created the desired media element, the software module inserts a unique identifier for the created media element into the web page. (Specification, 10:20-28.)

2. Claim 28

Claim 28 is directed to a computer-readable medium containing instructions for controlling a computer system to create a web page by a method that is similar that as describe for claim 22.

3. Claim 36

Claim 36 is directed to a computer system for creating a web page. The computer system includes components that perform a method similar to that of claim 22. The computer system additionally includes components that allow a screen shot to be included in a spec, that generate a report of unfilled specs, and that notify the writer when the desired media element has been created. (Specification, 3:1-10.)

III. GROUND'S OF REJECTION TO BE REVIEWED

A. The Examiner's Rejections

The Examiner has rejected all the pending claims pursuant to 35 U.S.C. § 103(a) as being unpatentable over King in view of Estrada.

It is the Examiner's position "King discloses a method in which media elements have existing specs which are displayed to web writers so they can locate a desired media." (Office Action, Nov. 29, 2005, p. 2.) The Examiner believes that King's "content element" corresponds to the claimed "media element" and that King's "design description" corresponds to the claimed "spec." (Id. at p. 6.) The Examiner further states "that content elements have a design description that a user can view to determine which content is wanted, and the design description may be changed accordingly (creating a new spec) to generate a [sic] different content elements." (Id.) The Examiner believes that "design descriptions correspond [sic, to] the very broadly defined term "spec" in the applicant's claim." (Id.)

B. Issues

1. Whether King's design description is "a spec describing the desired media element as indicated by the writer."

2. Assuming, *arguendo*, that a design description is a "spec," whether King displays to a writer existing design descriptions for content elements so that the writer can locate a desired content element.
3. Assuming, *arguendo*, that a design description is a "spec," whether King describes attaching a screen shot of a content element to a design description.
4. Whether "accelerated productivity in creation and maintenance of collaborative content" is sufficient motivation for combining King and Estrada when the Examiner points to nothing in the prior art that suggests this advantage of the combination.

IV. ARGUMENTS

A. Legal Standards for Obviousness

All of the claims stand rejected as obvious under 35 U.S.C. § 103(a). 35 U.S.C. § 103(a) provides:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

"[T]he [E]xaminer bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d (BNA) 1955, 1956 (Fed. Cir. 1993). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in

the art.'" *Id.* (quoting *In re Bell*, 991 F.2d 781, 782, 26 U.S.P.Q.2d (BNA) 1529, 1531 (Fed. Cir. 1993)).

To establish a *prima facie* case of obviousness, the Examiner must (1) identify prior art references that disclose all the elements of the claims, and (2) provide a suggestion or motivation to modify the references to produce the claimed invention. MPEP § 2143. With respect to the second requirement, the Examiner must provide a suggestion or motivation to combine from within the prior art, and may not rely upon hindsight gleaned from applicants' invention itself. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-51, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir. 1988).

Under these standards, applicant's invention would not have been obvious.¹ The Examiner has not identified prior art references that disclose all the elements of the pending claims. The Examiner also has not provided any motivation from within the prior art to modify the cited references so as to produce the claimed invention. The pending claims should be allowed.

B. King's Design Description is Not a "Spec"

A "spec" describes and identifies a media element that is to be included in a web page. Applicant's specification states that a writer "writes a specification ("spec") which describes and identifies what media is needed at that point in the document." (Specification, 2:6-8.) Moreover, all of the claims recite "a spec describing the desired media element."

King's design description, which the Examiner believes corresponds to applicant's spec, describes a format for the overall layout of a web page. King's design description

¹ It is the Examiner's position that "the applicant is responsible for all of the teachings of King when considering how the reference relates to possible patentability of the applicant's invention." (Office Action, Nov. 29, 2005, p. 6.) The Examiner is clearly attempting to shift his burden of establishing a *prima facie* case of obviousness to applicant's burden of proving that the cited references do not disclose the claimed invention. This is clearly impermissible.

may specify a calendar format, newsletter format, or other format. King renders content in accordance with the design description.

King's design description thus describes a format for layout and does not describe or identify a media element as does a spec. In addition, King's design description is not used "to create the desired media element for the web page."

C. King Does Not Display Existing Design Descriptions so That a Writer Can Locate a Desired Content Element

Applicant is puzzled by the Examiner's position that King's existing design descriptions are displayed to writers so that they can locate content elements. Applicant can find nothing in King that describes displaying design descriptions to a writer.

Moreover, there is nothing in King to suggest design descriptions can be used to locate content elements. Since a design description describes a format for a layout, it is not clear how such a format could help someone locate a desired content element.

D. King Does Not Describe Attaching a Screen Shot of a Content Element to a Design Description

Again, applicant is puzzled as to what in King corresponds to attaching a screen shot of any sort to a design description. A design description is a format. Applicant does not know why one would attach a screen shot to a description of a format. Applicant can find no suggestion in the cited portions, or any other portion, of King to do so.

E. The Examiner Has Not Provided a Sufficient Motivation to Combine King and Estrada and Thus Has Not Even Established Even a *Prima Facie* Case of Obviousness

The Examiner believes that it would have been obvious to combine King and Estrada because the combination would have resulted in "accelerated productivity." The Examiner, however, provides nothing in support of this conclusory statement. First, the

Examiner points to nothing in King or Estrada that suggests that they should be combined and especially not in the manner suggested by the Examiner. Second, the Examiner points to nothing in King or Estrada to suggest that the combination would result in "accelerated productivity" or what that accelerated productivity would be. The Examiner is impermissibly using the advantages of applicant's invention that are clear from applicant's specification as a suggested advantage of the combination.

Based upon these remarks, applicant respectfully requests reconsideration of this application and its early allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-8548.

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